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William K. Slate II

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EXAMINER

LONG, FONYA M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/991,223	Applicant(s) SLATE ET AL.	
	Examiner FONYA LONG	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,51-56,101-106 and 151-177 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,51-56,101-106 and 151-177 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following is a second Non-Final Office Action in response to communications received July 15, 2008. Claims 153, 154, 162, 163, 171, and 172 have been amended. Claims 1-6, 51-56, 101-106, and 151-177 are currently pending and have been considered below.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 and 151-159 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to claims 1-6 and 151-159, the claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 51-52, 101-102, 151-152, 156, 160-161, 165, 169-170, and 174 are rejected under 35 U.S.C. 102(b) as being anticipated by Sloo (5,895,450) (hereinafter referred to as Sloo).

As per Claim 1, Sloo discloses a method for guiding a user through dispute resolution a dispute management application comprising:

receiving an indication from the user to create a profile from a first computer, wherein the profile comprises dispute resolution-relating information associated with the user and a dispute (Fig. 2(200); Fig. 3(300, 302, 304, 306); Col. 4, Lines 1-17; Col. 4, Lines 45-60; Col. 4, Line 45-Col. 5, Line 1);

in response to receiving the profile information at a second computer, determining a subplurality of dispute resolution paths for resolving the dispute from a plurality of dispute resolution paths based on the profile, wherein each of the dispute resolution paths comprises a plurality of steps for implementing at least one dispute resolution mechanism (Fig. 7 (700) settle dispute; Col. 7, Lines 29-40; Col. 10, Lines 22-34).

determining estimated dispute resolution information for the determined dispute for each of the determined paths based on the profile;

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displaying at the first computer the plurality of steps for the determined dispute resolution paths for resolving the dispute and the estimated dispute resolution information (Col. 2, Lines 43-61; Col. 3, Lines 8-17; Col. 7, Lines 29-40; Col. 10, Lines 13-Col. 11, Line 5);

prompting the user at the first computer to select the determined dispute resolution path (Col. 4, Lines 63-65; Col. 5, Lines 49-56; Col. 7, Lines 29-40);

in response to receiving the selection, initiating the selected path (Col. 7, Lines 29-49).

As per Claims 51 and 101, Sloo discloses a system for guiding a user through dispute resolution using a dispute management application comprising:

a user input device, a display device (means for displaying) (Fig. 1(14));

means for receiving an indication from the user to create a profile from a first computer, wherein the profile comprises dispute resolution-related information associated with the user (Fig. 1(14));

means for determining a mechanism/ dispute resolution path for resolving a dispute based at least in part on the profile in response to the indication at a second computer (artificial intelligence; Col. 12, Lines 48-61; Col. 13, Line 59-Col. 14, Line 16; Col. 14, Lines 61-67; Col. 15, Lines 21-30); and

means for providing the user at the first computer with the mechanism for resolving the dispute (Figures 1-9);

means for prompting the user to select the determined dispute resolution path (Col. 4, Lines 63-65; Col. 5, Lines 49-56).

As per Claims 2, 52, and 102, Sloo discloses wherein the mechanism is selected from the group consisting of documents-only arbitration and on-call mediation (Col. 7, Lines 29-40, Col. 8, Lines 34-49).

As per Claims 151, 160, and 169, Sloo discloses the providing success rate information (Col. 8, Line 60-Col. 9, Line 10).

As per Claims 152, 156, 161, 165, 170, and 174, Sloo discloses wherein a first determined dispute resolution path implements at least two dispute resolution mechanisms (Fig. 7).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 5-6, 53, 55-56, 103 and 105-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo as applied to Claims 1, 51, and 101 above, and further in view of Vaidyanathan et al. (US 2004/0059596) (hereinafter referred to as Vaidyanathan).

As per Claims 3, 53, and 103, Sloo discloses the method and system of claims 1, 51, and 101. Sloo discloses intervention by a third party to resolve the dispute, the third party selected from a pre-qualified list (Col. 8, Lines 5-18).

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Sloo does not explicitly disclose what the qualifications are for one to be on the pre-qualified list or that the person is certified.

However, Vaidyanathan discloses determining whether the user has met a predetermined standard for conducting business [0043-0044]; and

providing the user with a certification in response to meeting the predetermined standard [0043-0044] the Examiner is interpreting the fact that the specialist can be a person who has successfully completed a comprehensive mediation training with defined criteria for successful completion to meet the language of providing a certification).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the complaint handling method and system of Sloo having a list of pre-qualified third party members who can intervene with the training and criteria taught in Vaidyanathan so that the pre-qualified third party members will be fully equipped with substantial experience mediating or arbitrating a range of disputes, thus enabling a higher rate of successful resolutions of disputes.

As per Claims 5, 55, and 105, Sloo discloses monitoring how long it takes for parties to respond (Col. 5, Lines 30-37).

Sloo does not disclose determining an estimated time for resolving the dispute and providing the user with the estimate time.

However, Vaidyanathan teaches predetermined time periods [0065-0069].

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the complaint handling method and system of

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Sloo the time periods taught in Vaidyanathan so that the case can be quickly moved along rather than letting it languish and drag out without any resolution. It would be necessary to know the approximant times needed for resolving a dispute so that notifications can be sent to nudge the parties on and so that the system can know when an appropriate amount of time to resolve the dispute has passed without resolution, thus moving the case to the next step, either by dismissing the case or moving it to another avenue for resolution.

As per Claims 6, 56, and 106, Sloo discloses monitoring the conduct of all of the parties and storing the information in performance records. Sloo discloses when the program uses artificial intelligent techniques to make decisions regarding a dispute; it considers the performance records of all participants to the dispute when rendering a judgment (Col. 9, Lines 40-48).

Therefore, it would have been obvious for Sloo to compare the dispute to a plurality of past dispute records when determining an estimate of time since Sloo already monitors conduct and stores performance records. Sloo further uses this information to analyze various scenarios using the gathered information and determining the best solution or outcome. Therefore, time estimates would also be easy to add to the information monitored and stored by Sloo since a party who does not promptly respond or who delays resolution by taking their time to respond would alter the outcome or direction the method and system would take in resolving the dispute, and further, would provide information to update that performers performance record to be used in any future disputes.

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6. Claims 4, 54, 104, 155, 164, and 173 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo as applied to Claims 1, 51, and 101 above, and in further view of Kilibaner (US 2002/0161597).

As per Claims 4, 54, and 104, Sloo does not explicitly disclose calculating a cost for resolving a dispute or that calculating cost comprises calculating an average cost.

However, Kilibaner discloses calculating a cost for resolving the dispute and providing the user with the cost (Fig. 2 (206)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the complaint handling method and system of Sloo the cost calculation taught in Kilibaner since this provides an efficient way for the parties to choose the rules, regulations and procedures which will apply in the dispute resolution process. The Examiner asserts that using an average cost of similar disputes is routinely done in any business practice. For example, attorneys on a daily basis provided clients with information as to an estimate for taking case to trial verses trying to settle the case out of court. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to use an average cost when calculating a cost since this is generally how businesses operate.

7. Claims 153-154, 157-159, 162-163, 166-168, 171-172, and 175-177 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo.

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Sloo does not disclose that the dispute resolution path is based on the size of the dispute amount or the relationship between the user and a disputing party.

The Examiner asserts that one of ordinary skill in the art would take into account the size of the dispute amount when determining the type of dispute resolution to take. For example, if the dispute amount is small, the a user may decide to do negotiations instead of litigation, since the litigation costs could outweigh the dispute amount or reduce the amount awarded to the user after litigation costs have been paid minimal.

The Examiner also asserts that one or ordinary skill in the art would take into account the relationship of the parties in determining a path for dispute resolution. For example, if the two parties disputing are really angry with each other such that it becomes impossible to negotiate or mediate, the arbitration or litigation would be the preferred path. However, if the two parties are amicable and may have to maintain contact with each other, for example, a couple in a divorce with children, then the preferred path may be negotiation or mediation rather than arbitration.

Therefore, the Examiner asserts that one of ordinary skill in the art at the time of the invention would take into account the size of the dispute amount and the relationship of the parties since this information is used daily by those in the legal community to make recommendations to their clients. Common sense dictates that one use this information to make a determination of which dispute resolution path to recommend.

As per Claims 157-159, 166-168, and 175-177, Sloo discloses multiple paths to settle a dispute (Fig. 7). Sloo does not disclose that the first path will move from a first dispute mechanism to a second mechanism only when the first mechanism does not result in resolution, or that the path will be moved without user intervention or that the paths are identified as documents only arbitration or on-call mediation, followed by arbitration.

However, the Examiner takes Official Notice that it is old and well known to move from one dispute resolution path to another if there is no resolution of the dispute. Case in point, a domestic case where the parties are fighting over custody and support. Generally, due to the over crowded courts and because it is in the best interest of the parties to try to resolve the matter on their own, prior to litigation, judges often order the parties to mediation. Then, if mediation fails to work, the parties go into litigation.

Therefore, it would have been obvious to one of ordinary skill in the art to move from one path to another if a dispute is not resolved since this is common business practice.

As for the different paths, i.e., documents only arbitration, on call mediation, the Examiner asserts again that creating these paths as options would have been obvious to one of ordinary skill in the art.

Response to Arguments

8. Applicant's arguments filed July 15, 2008 have been fully considered but they are not persuasive.

Applicant's arguments, see pages 14-21, filed July 15, 2008, with respect to Claims 1-6, 51-56, 101-106, and 151-177 have been fully considered and are persuasive. The 112 1st rejection for the written description requirement of Claims 1-6, 51-56, 101-106, and 151-177 has been withdrawn.

As per Claims 1, 51, and 101, Applicant argues that Sloo fails to disclose "determining a sub-plurality of dispute resolution paths for resolving the dispute from a plurality of dispute resolution paths based on the profile". Examiner asserts that Sloo discloses employing artificial intelligence processing to analyze various scenarios using gathered information (i.e. profile information) to determine the best solution (i.e. dispute path) or outcome to a dispute (Col. 10, Lines 22-34).

Applicant argues that Sloo fails to disclose "determining estimated dispute resolution information at the second computer for each of the determined dispute resolution paths based on the profile" and "displaying the estimated information ". Examiner asserts that Sloo discloses determining estimated dispute resolution information by monitoring participant behavior in certain situations and outcomes over time, and comparing the current situation with other similar situations having known outcomes and predict (i.e. estimate) the outcome for the present situation based on these known outcomes. Sloo also discloses suggesting (i.e. displaying) the best behavior to the user to reduce the number of complaints (Col. 10, Line 54-Col. 11, Line 5).

Applicant also argues that Sloo fails to disclose "displaying at the first computer the plurality of steps for the determined dispute resolution paths for

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resolving the dispute". Examiner asserts that Sloo discloses if the "Negotiate the Complainant" option is selected, the program provides (i.e. displays) initial instructions (i.e. steps) for the negotiation process (Col. 7, Lines 41-49).

As per Claims 151, 160, and 169, Applicant argues that Sloo fails to disclose "determining estimated dispute resolution information by providing success rate information for similar disputes resolved using each of the determined dispute resolution paths". Examiner respectfully disagrees. Examiner asserts Sloo discloses providing success rate information by rating the parties involved in disputes wherein the rating or score for the prevailing party is increased, while the rating or score for the losing party is decreased (Col. 8, Lines 50-58). Sloo also discloses using the rate information (i.e. gathered information) to predict (i.e. estimate) the outcome for the present situation (Col. 10, Line 54-Col. 11, Line 5).

As per Claims 152, 156, 161, 165, 170, and 174, Applicant argues that Sloo fails to disclose "determining two dispute paths from a plurality of dispute paths based on a profile or a dispute resolution path that implements at least two dispute resolution mechanisms". Examiner respectfully disagrees. Examiner asserts that Sloo discloses a dispute resolution path that implements at least two dispute resolution mechanisms via providing a "Appeal a Decision" path in addition to one of the three settlement options (i.e. path) selected (Fig. 7; Col. 7, Lines 29-41).

As per Claims 3, 53, and 103, Applicant argues that the Sloo and Vaidyanathan combination fails to disclose "determining whether a user has met

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a predetermined standard for conducting business and in response providing the user a certification". Examiner respectfully disagrees. Examiner asserts that Vaidyanathan discloses utilizing a dispute resolution specialist (i.e. a certified person) which has completed comprehensive mediation training ([0043]).

Vaidyanathan also discloses determining whether a user has met a predetermined standard via determining whether the dispute resolution specialist has successfully completed training ([0044]). Examiner also asserts it would have been obvious to one of ordinary skill in the art to incorporate certified third parties to in the Sloo dispute resolution system to maintain the integrity of the system.

As per Claims 5, 55, and 105, Applicant argues that the Sloo and Vaidyanathan combination fails to disclose "determining the estimated time for resolving disputes using each of the determined dispute resolution paths". Examiner respectfully disagrees. Examiner asserts that Vaidyanathan discloses determining the estimate time for resolving disputes via having a predetermined period of fourteen days for resolving a dispute ([0065]).

As per Claims 4, 54, 104, 155, 164, and 173, Applicant argues that the Sloo and Kilibaner combination fails to disclose "calculating a cost for resolving disputes using each of the determined dispute resolution paths or calculating these costs by calculating an average cost of a plurality of disputes resolved using each of the determined dispute resolution paths". Examiner respectfully disagrees. Examiner asserts Kilibaner discloses allocating (i.e. determining) costs for resolution of a dispute (Fig. 2). Examiner asserts it would have been obvious to combine the feature disclosed in Kilibaner with the method and

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system of Sloo in order to aid a party in determining what dispute path to take based on the cost involved in each dispute path.

As per Claims 153, 154, 162, 163, 171, and 172, Applicant argues that Sloo fails to disclose “determining the dispute resolution paths based on a size of the dispute amount or based on a relationship between the user and a disputing party. Examiner respectfully disagrees. Examiner asserts although Sloo fails to disclose determining the dispute resolution paths based on a size of the dispute amount or based on a relationship between the user and a disputing party, it would have been obvious to one of ordinary skill in the art to take into account the size of the dispute amount when determining the type of dispute resolution to take. For example, if the dispute amount is small, the a user may decide to do negotiations instead of litigation, since the litigation costs could outweigh the dispute amount or reduce the amount awarded to the user after litigation costs have been paid minimal.

The Examiner also asserts that one or ordinary skill in the art would take into account the relationship of the parties in determining a path for dispute resolution. For example, if the two parties disputing are really angry with each other such that it becomes impossible to negotiate or mediate, the arbitration or litigation would be the preferred path. However, if the two parties are amicable and may have to maintain contact with each other, for example, a couple in a divorce with children, then the preferred path may be negotiation or mediation rather than arbitration.

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As per Claims 157-159, 166-168, and 175-177, Applicant argues that Sloo fails to disclose “a first determined dispute resolution path will move from a first dispute mechanism to a second mechanism only when the first dispute mechanism does not result in a resolution. Examiner asserts that it is old and well known to move from one dispute resolution path to another if there is no resolution of the dispute. Case in point, a domestic case where the parties are fighting over custody and support. Generally, due to the over crowded courts and because it is in the best interest of the parties to try to resolve the matter on their own, prior to litigation, judges often order the parties to mediation. Then, if mediation fails to work, the parties go into litigation.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thur 7:30am-6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. L./
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689